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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,797	03/05/2002	Raymond John Herbert	5126	2997

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EXAMINER

CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,797

Applicant(s)

HERBERT, RAYMOND JOHN

Examiner

Debra F. Charles

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments with respect to claims 11-12 and 14-20 are have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11, 18, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In these claims, it can not be determined if the processing of the first mail item has not been completed since there is no indication whether processing has or has not been completed. As per the first postage indicium is suitable for use in relation to the second mail item, it is not clear what makes it suitable, since many variables are used to create indicia.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-12 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al.(U.S.PAT. 5768132A).

Re claim 11: Cordery et al. disclose a method of mail preparation, including the steps of:

processing a first mail item comprising a mail item in a series of mail items(col. 2, lines 20-40);

effecting an accounting operation in respect of a first postage charge for the first mail item, and generating a first postage indicium to provide evidence that the accounting operation has been effected in respect of the first postage charge(col. 4, lines 50-67);

processing a second mail item comprising a mail item, subsequent to the first mail item, in the series of mail items(col. 2, lines 20-40);

determining whether the first postage charge remains unused because processing of the first mail item has not been completed(col. 2, lines 20-40);

where the first postage charge is unused, determining whether the first postage indicium is suitable for use in relation to the second mail item(col. 2, lines 20-40);

where the first postage indicium is suitable for use in relation to the second mail item, generating a postage indicium to provide evidence in relation to the second mail item that the accounting operation has been effected in respect of the first postage charge(col. 11, line 15-col. 12, line 45); and

where the first postage indicium is not suitable for use in relation to the second mail item, effecting an accounting operation in respect of a second postage charge for the second mail item, and generating a second postage indicium to provide evidence that the accounting operation has been effected in respect of the second postage charge(col. 2, lines 20-40, col. 4, lines 50-67).

Cordery et al. does not explicitly disclose substitute. However, the reference does refer to generating a replacement indicum in col. 12, lines 35-45. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ a substitute or replacement indicum to get the benefit of completely using available indicum to ensure suitable postage affixed to the mail piece.

Re claim 12: Cordery et al. disclose wherein the substitute postage indicium is generated as a modification of the first postage indicium(col. 11, line 15-col. 12, line 45, i.e. reuse).

Re claim 14: Cordery et al. disclose wherein the substitute postage indicium includes a cryptographic token and the cryptographic token is based in part upon the indicator (col. 4, lines 50-67).

Re claim 15: Cordery et al. disclose wherein the first postage indicium is generated to include a flag in a first state, and the substitute postage indicium is generated with the flag in a second state different from the first state(col. 8, lines 1-40, col. 12, lines 55-67).

Re claim 16: Cordery et al. disclose wherein the substitute postage indicum includes a cryptographic token and the cryptographic token is based in part upon the state of the flag(col. 4, lines 50-67, col. 8, lines 1-40, col. 12, lines 55-67).

Re claim 17: Cordery et al. disclose wherein the step of generating the first postage indicium is based at least in part on a recipient address, and the step of determining whether the first postage indicium is suitable for use in relation to the second mail item includes the step of determining whether the recipient address of the second mail item is the same as the recipient address of the first mail item(col. 3, lines 10-col. 4, line 10).

Re claim 18: Cordery et al. disclose further including the steps of storing the first postage indicium and a marker relating to the stored first postage indicium(col. 3, lines 10-35, lines 64-67); and setting the marker where processing of the first mail item is not completed (col. 12, lines 55-67, i.e. a flag is a marker).

Re claim 19: Cordery et al. disclose further including the step of resetting the marker relating to the stored first postage indicium where the first postage indicium is determined to be suitable for use in relation to the second mail item(col. 3, lines 10-35, line 64-col. 4, line 10,col. 12, lines 55-67, i.e. a flag is a marker).

Re claim 20: Cordery et al. disclose an accounting unit operable to effect an accounting operation in respect of postage charges for mail items in a series of mail items, and generate postage indicia to provide evidence that accounting operations have been effected in respect of the postage charges;

wherein the accounting unit is configured to:

effect an accounting operation in respect of a first postage charge for a first mail item in a series of mail items, and generate a first postage indicium to provide evidence that the accounting operation has been effected in respect of the first postage charge;

and

in processing a second mail item comprising a mail item, subsequent to the first mail item, in the series of mail items, determine whether the first postage charge remains unused because processing of the first mail item has not been completed, and, where the first postage charge is unused, determine whether the first postage indicium is suitable for use in relation to the second mail item, and, where the first postage indicium is suitable for

use in relation to the second mail item, generate a postage indicum to provide evidence in relation to the second mail item that an accounting operation has been effected in respect of the first postage charge, and, where the first postage indicum is not suitable for use in relation to the second mail item, effect an accounting operation in respect of a second postage charge for the second mail item, and generate a second postage indicum to provide evidence that an accounting operation has been effected in respect of the second postage charge(col. 2, lines 20-40, col. 4, lines 50-67, col. 11, line 15-col. 12, line 45).

Cordery et al. does not explicitly disclose substitute. However, the reference does refer to generating a replacement indicum in col. 12, lines 35-45. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ a substitute or replacement indicum to get the benefit of completely using available indicum to ensure suitable postage affixed to the mail piece.

Allowable Subject Matter

6. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra F. Charles
Examiner

Art Unit 3624



VINCENT MILLIN
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